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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,899	10/28/2003	Isabelle Rollat	5725.0912-01	2642

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EXAMINER	
ZALUKAEVA, TATYANA	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/693,899	ROLLAT ET AL.	
	Examiner	Art Unit	
	Tatyana Zalukaeva	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17,37,53 and 73* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17,37,53 and 73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 17, 37, 53 and 73 are pending in the Application and are directed to an aerosol devise

Double Patenting

2. Claims 17, 37, 53 and 73 of this application conflict with claims 16, 35, 49 and 68 of Application No. 10/395,064. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 17, 37, 53 and 73 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16, 35, 49 and 68 of copending Application No. 10/395,064. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 17, 37, 53, and 73 arerejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. 6,689,346 and over claim 11 of U.S. 6,645,478. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 53 has each and every element of the conflicting claims, and claims 17, 37, and 73 disclose genetically the ingredients that are exemplified by specific species of U.S.'346 and U.S.'478. The species always anticipate genus (Ex parte A), and the genus in the

instant claims of makes the species of U.S.'346 and U.S.'478 obvious. The difference in preamble between the instant claims and that of conflicting patents is that the preamble of the instant claims recites composition comprising heterogeneous particles, while the other two applications recite composition comprising at least one copolymer.

However, the exact similarity of the body of claims, namely the make-up and numerical characteristics of polymers makes the compositions inherently identical to each other.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 17, 37, 53 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolich, Jr. et al (U.S. 5,662,892).

The disclosure of Bolich reads on the instant claims as follows:

Bolich discloses hair care compositions containing hydrophobic random copolymers (abstract). Specifically preferred copolymer named, discussed and detailed by Bolich is Poly(isobornyl acrylate-co-2-ethylhexyl acrylate) 70:30 (col. 5, lines 40-45, col. 22, Example 2). A composition comprises a suitable carrier or hair care matrix from 50% to 99.3%, leaving the rest up to a 100% for copolymer (col. 7, lines 35-40).

The preferred composition of Bolich is in the form of a discontinuous phase of dispersed droplets or particles of the copolymer and a volatile solvent distributed throughout the carrier (col. 7, lines 48-50). The carrier can also comprise thickeners, gelling agents, etc. The composition can be in the form of liquids, lotions, creams, gels, shampoos, mousses (col. 7, lines 50-59).

Another polymer can also be added to a composition, such as combination of one or more nonionic water soluble polymeric materials (col. 9, lines 6-12), which is hydrophobically modified, such polymers are described in col. 9, lines 40-64. The composition can also contain a cationic organic polymer, which is generally present in the amounts of 0.05-5% (col. 17, lines 17-25). Suitable cationic polymers are disclosed in col. 18, lines 12-64.

Since the composition of Bolich is in the form of discontinuous phase of dispersed droplets or particles, as stated in col. 7, lines 48,48, this inherently means that the composition is heterogeneous and reshapable. Since the polymers of Bolich are identical to those instantly claimed the glass transition temperature is believed to be inherently within the claimed range. The above rejections were made in the sense of ***In re Fitzgerald*** or ***In re Spada***, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990),

which settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art. With regard to propellant and dispenser, Bolich teaches that hair care compositions are used in conventional ways to provide the desired benefit appropriate to the product such as hair styling, holding, cleansing, conditioning and the like for hair care compositions (as in the case of **spray,** mousse, or gel products). The present invention is especially adapted for rinse off hair care compositions. Hair **sprays** are typically applied to dry hair after it has already been dried and styled. Thus being a hair spray it should inherently contain propellant and being used from a dispenser.

Therefore all the limitations of the instant claims are either expressly or inherently met by the disclosure of Bolich.

8. Claims 17, 37, 53 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al (U.S. 6,214,328).

The disclosure of Chang reads on the rejected claims as follows:
Chang discloses ***aerosol*** hair styling compositions comprising polymers containing 5-95% (C1 -C10)alkyl (meth)acrylate, 0-70% hydroxyalkyl (meth)acrylate, 0-50% monocarboxylic acid monomer and 1-25% dicarboxylic acid monomer. The selected polymers are particularly useful in aqueous hair styling compositions containing low (80% orless) volatile organic compound (VOC) concentrations.
Examples 5, 6, 12, 13, 20-23 in Table 2, col. 8 disclose compositions as instantly claimed :

10 IBOA/15 BA/47 MMA/10 HEMA/18 MAA with SLS

10 IBOMA/15 BA/47 MMA/10 HEMA/18 MAA with SLS

21 BA/4 IBOMA/47 MMA/10 HEMA/13 MAA/5 IA with PPE-1

18 BA/7 IBOMA/47 MMA/10 HEMA/13 MAA/5 IA with PPE-1

21 BA/4 IBOA/47 MMA/10 HEMA/18 MAA with SLS

18 BA/7 IBOA/47 MMA/10 HEMA/18 MAA with SLS

21 BA/4 IBOMA/47 MMA/10 HEMA/13 MAA/5 IA with SLS

21 BA/4 IBOMA/47 MMA/10 HEMA/18 MAA with SLS

Preservatives, thickeners, **propellants**, emulsifiers, colorants, etc, all additives known to those skilled in the art are detailed and referred to as suitable additives for Chang's composition (col. 7, lines 1-55).

Styling compositions of Chang are used in sprays, aerosols, utilizing some propellants known in the art.

Since Chang utilizes the composition in aerosol form, using propellants (col. 7, lines 6-10), the composition is inherently heterogeneous containing polymer particles by the virtue of definition of "aerosol" as suspension of liquid or solid particles well known by those skilled in the art.

With regard to addition of the other (second acrylic polymer) polymer to a composition, Chang teaches that the low-VOC hair styling compositions may also be blended with **one or more other hair fixative resins**. Suitable hair fixative resins include, for example, the acrylic hair fixative resins described previously, and other soluble hair resins such as, for example, butyl acrylate/ethyl acrylate/methacrylic acid

copolymers, vinyl pyrrolidone/vinyl acetate copolymers, octylacrylamide/acrylates/butylaminoethyl-methacrylate copolymers, vinylcaprolactam/vinyl-pyrrolidone/dimethylaminoethyl-methacrylate copolymers, methacryloyl ethylbetaine/methacrylate copolymers, methacrylic acid/methacrylic ester copolymer, acrylates/hydroxyesters acrylates copolymer and methacrylic acid/acrylic acid ester copolymers. Preferably, the soluble hair fixative resins are the acrylic hair fixative resins described previously. Chang disclose aerosol, therefore the dispenser is inherent.

Therefore the limitations of rejected claims are disclosed by Chang.

9. Claims 17, 37, 53 and 73 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rollat et al (U.S. 6,689,346)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.
See abstract, col.2, lines 13-18, claims 1 and 9.

Information Disclosure Statement

10. The references cited by applicants in the IDS and listed on the numerous 1449's have been made of record. While the statements filed clearly do not comply with the guidelines set forth in MPEP 2004 regarding both the number of references cited and the eliminaiton of clearly irrelevant art and marginally cumulative information, compliance with these guidelines is not mandatory. Futhermore, 37 CFR 1.97 and 1.98 dose not require that the information be material, rather they allow for submission of information reagardless of its pertinence to the claimed invention. Also, there is no requiremnt to explain the materiallity of the submitted references, however, the cloaking of a clearly relevant reference by inclusion in a long list of citations may not comply with Applican's duty of disclosure, see Penn Yan Boats, inc. V. Sea Lark boats Inc., 359 F. Supp. 948, aff'd 479 F. 2d. 1338.

11. Several references on the IDS (PTOL-1449) were not considered, because they have nothing in common with the claimed invention and apparently came from another Application: U.S.5,938,058 "Segmented multipurpose portable container" and U.S. 6,168,866 " Abrasion and stain resistant curable fluorinated coating".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva
Primary Examiner
Art Unit 1713

March 30, 2005